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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,405	12/15/2003	William Sobonya	MAEE 2 00034	6233
27885	7590	11/15/2006		
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114				
			EXAMINER RUDDOCK, ULA CORINNA	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 11/15/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/736,405

Applicant(s)

SOBONYA, WILLIAM

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/23/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 23, 2006, has been entered.
2. The Examiner has carefully considered Applicant's amendment and accompanying remark filed June 26, 2006, and August 23, 2006. the rejection in view of Hamilton (US 2005/0112314) has been overcome. However, after an updated search, additional prior art has been found which renders the currently claimed invention unpatentable.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Amendment***

4. The declaration under 37 CFR 1.132 filed June 26, 2006, is insufficient to overcome the rejection of claims 1-15 based upon Hawley et al. (US 6,130,174) and Hamilton et al. (US 2005/0112314) as set forth in the last Office action because: it states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

Furthermore, gross sales do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F. 2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988). See MPEP § 716.03

Applicant further discusses that “no extensive advertising was conducted” on the liners of the present invention. It is unclear what is meant by “extensive.”

#### ***Status Identifier***

5. It should be noted that the status identifier for Claim 15 is incorrect. It should read “Currently Amended” since the claim has been amended.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to read on a covering that “remains indefinitely repositionable.” There is no support for this limitation in the specification. Correction is required.

***Claim Rejections - 35 USC § 103***

7. Claims 1-4, 6, 7, 9, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) in view of Hawley et al. (US 2002/0192416). Hawley et al. disclose a laminate having nonslip characteristics. The laminate comprises a smooth film and a scrim (abstract). The scrim is woven plastic scrim (col 2, ln 56-58) coated by a polyvinyl chloride plastic (claim 1). A vinyl plastic film (col 3, ln 4-10) is laminated to the scrim via an adhesive (col 4, ln 40-42). The vinyl film has a thickness of .004-.008 inches, 4-8 mils (col 2, ln 5-7). Hawley et al. disclose the claimed invention except for the teaching that the laminate is embossed and that the laminate is repositionable.

Hawley et al. (US 2002/019216) disclose a shelf liner having a synthetic paper substrate, wherein the substrate has a polymeric material on a first surface and a repositionable adhesive on a second surface (abstract). The synthetic paper can be decorated by embossing the thin polymeric film on its upper surface [0021]. A repositionable adhesive is applied to the back surface of the paper shelf liner [0022]. It would have been obvious to one having ordinary skill in the art to have used Hawley's embossing steps and repositionable adhesive on the laminate of Hawley '174, motivated by the desire to create a shelf liner that is repositionable and that has a pattern or design on the surface.

It also would have been obvious to one having ordinary skill in the art to have made the textured finish to have a leather or linen-like appearance, motivated by the desire to create a laminate that blends in with its surroundings.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) and Hawley et al. (US 2002/0192416) as applied to claim 1 above, and further in view of Owen (US 5,874,371). Hawley et al. and Hawley et al. disclose the claimed invention except for the teaching that the scrim comprises a non-woven scrim.

Owen (US 5,874,371) discloses a non-skid covering for use on a surface (abstract). The scrim comprises a PVC coated non-woven scrim (claims 5 and 6). It would have been obvious to have used Owen's coated non-woven scrim as the scrim in the laminate of Hawley et al. and Hawley et al., motivated by the desire to create a laminate having cheaper processing costs.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) and Hawley et al. (US 2002/0192416) as applied to claim 1 above, and further in view of Aliabadi (US 2003/0036323). Hawley et al. and Hawley et al. disclose the claimed invention except for the teaching that the scrim is a polyester.

Aliabadi (US 2003/0036323) disclose a shelf liner comprising a top layer of a smooth polyvinyl chloride covering a sandwich layer of a polyester fabric between layers of polyvinyl chloride (abstract). A layer of polyester mesh fabric is between layers of polyvinyl chloride [0023]. It would have been obvious to have used the polyester mesh of Aliabadi in the laminate of Hawley et al. and Hawley et al., motivated by the desire to create a laminate having the effects and properties associated with polyester.

10. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) in view of Hawley et al. (US 2002/0192416) and Schottenfeld (US 2002/0094404). Hawley et al. disclose a laminate having nonslip characteristics. The laminate comprises a smooth

film and a scrim (abstract). The scrim is woven plastic scrim (col 2, ln 56-58) coated by a polyvinyl chloride plastic (claim 1). A vinyl plastic film (col 3, ln 4-10) is laminated to the scrim via an adhesive (col 4, ln 40-42). The vinyl film has a thickness of .004-.008 inches, 4-8 mils (col 2, ln 5-7). Hawley et al. disclose the claimed invention except for the teaching that the laminate is embossed and that there is a protective removable covering on the laminate.

Hawley et al. (US 2002/019216) disclose a shelf liner having a synthetic paper substrate, wherein the substrate has a polymeric material on a first surface and a repositionable adhesive on a second surface (abstract). The synthetic paper can be decorated by embossing the thin polymeric film on its upper surface [0021]. A repositionable adhesive is applied to the back surface of the paper shelf liner [0022]. It would have been obvious to one having ordinary skill in the art to have used Hawley's embossing steps and repositionable adhesive on the laminate of Hawley '174, motivated by the desire to create a shelf liner that is repositionable and that has a pattern or design on the surface.

Schottenfeld (US 2002/0094404) discloses a liner for covering a generally smooth surface comprising a PVC sheet [0019] and a PVC coated scrim [0020]. A release layer is added to the liner [0024]. It would have been obvious to one having ordinary skill in the art to have used Hawley's embossing steps on the laminate of Hawley et al., motivated by the desire to create a laminate having a pattern or design on the surface. It would have been obvious to have used the release layer of Schottenfeld in the laminate of Hawley et al. and Hawley et al., motivated by the desire to create a laminate that has improved handling characteristics.

It also would have been obvious to one having ordinary skill in the art to have made the textured finish to have a leather or linen-like appearance, motivated by the desire to create a laminate that blends in with its surroundings.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UCR

*UCR*

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